REMARKS

Claims 1-59 are now pending in the application. Claims 1-59 are subject to restriction. Claims 1, 8 and 14 are amended and claims 5-6, 9-13, 16-19 and 24-59 are canceled herein. No new matter has been added.

In particular, concerning Groups I through III, Applicants respectfully traverse the Restriction and request that these Restrictions be reviewed and withdrawn for the following reasons.

Applicants would like to initially point out that Groups I through III (all directed to isolated 125P5C8-related proteins) have been classified by the Examiner as belonging to class 530, subclass 350. Thus, since all Groups are directed to 125P5C8-related proteins comprising the sequence of SEQ ID NO: 2, and they are in the same class and subclass, Applicants assert that no undue search burden is present. As will be discussed in greater detail below, the search of any of the Groups I through III would be identical. Because no burden of search is present in searching a single subclass (in contrast to the requirement for a "serious burden" at MPEP § 803), the reasons for restriction between these Groups are insufficient and the restriction may be properly withdrawn.

Groups II and III cover claims directed to a 125P5C8-related protein produced by a particular process. Groups II (claims 1, 14, 15, 16 and 23) and III (claims 1 and 14) encompass an isolated 125P5C8-related protein encoded by a nucleic acid and an isolated 125P5C8-related protein encoded by a cDNA, respectively. The only rationale provided for the restriction of these compositions (Groups I-III) is that they purportedly have "different structures, different chemical compositions, and different immunological properties" (see paper 8, page 4). As these groups encompass isolated 125P5C8-related proteins, it appears that the Examiner has differentiated these compositions based on how they are produced.

Respectfully, the restriction of Groups I, II and III appears to be inconsistent with current case law. For example, the Federal Circuit has stated, "[e]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production," rather, it depends on the end product formed. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); see also MPEP § 2113 for related discussion. Therefore, the restriction of the protein claims into Groups I through III is not understood as patentability resides in the product formed rather then the process used to produce the product. In this situation the end product, i.e., a 125P5C8-related protein comprising the sequence of SEQ ID NO: 2 is the same, as is the search.

Moreover, Applicants submit that the presently required restriction (as it pertains to claims 1, 14, 15 and 23 in asserted Groups I-III) is impermissible, as it is directed to restricting within particular claims. "If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits." *In re Weber*, 198 USPQ 328, 331 (Fed. Cir. 1978).

Accordingly, Applicants respectfully request that the restriction of Groups I through III be withdrawn, and that all relevant claims be examined as filed and amended by Applicants.

Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

In the unlikely event that the Patent Office determines that extensions and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or fees due to our Deposit

Account No. **03-1952** under Order No. **511582003500**. The Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: August 6, 2002 By: _____

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MARKED-UP VERSION OF AMENDMENTS TO THE CLAIMS

In the Claims:

Please replace pending claims 1, 8 and 14 with the following claims 1, 8 and 14:

1. (Amended) An isolated 125P5C8-related protein comprising the sequence of SEQ ID NO: 2.

8. (Amended) An 125P5C8-related protein of [of] claim 1 that comprises an epitope that induces a specific antibody response.

14. (Amended) An isolated 125P5C8-related protein of claim 1 that has an amino acid sequence which is exactly that of an amino acid sequence encoded by a polynucleotide selected from the group consisting of:

(a) a polynucleotide consisting of the sequence as shown in SEQ ID NO: 1, wherein T can also be U;

(b) a polynucleotide consisting of the sequence as shown in SEQ ID NO: 1, from nucleotide residue number 82 through nucleotide residue number 696, wherein T can also be U;

(c) a polynucleotide that encodes a 125P5C8-related protein whose sequence is encoded by the cDNAs contained in the plasmids designated *Escherichia coli* DH5A 125P5C8PRO [[***]] deposited with American Type Culture Collection as Accession No. PTA-3137 [[***]];

[(d) a polynucleotide that encodes an 125P5C8-related protein that is at least 90% homologous to the entire amino acid sequence shown in SEQ ID NO: 2;

(e) a polynucleotide that encodes an 125P5C8-related protein that is at least 90% identical to the entire amino acid sequence shown in SEQ ID NO: 2;]

(d) [(f)] a polynucleotide that is fully complementary to a polynucleotide of any one of (a)-(c) [(e)]; and,

(e) [(g)] a polynucleotide that selectively hybridizes under stringent conditions to a polynucleotide of (a)-(c) [(e)].